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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,780	10/17/2003	Reinhold Klipper	MO5664D/LeA 33,	9841

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/687,780

Applicant(s)

KLIPPER ET AL.

Examiner

Tatyana Zalukaeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicants amended the claims to direct claim 17 to a product-by-process.

Claims 17-24 are now pending.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17-20, 23 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Surowiec.

Surowiec teaches an ion exchange resin having chelating functional groups (abstract). This resin is obtained by converting aminomethylated bead polymers to aminoalkylphosphonic acid groups or imidoacetic acid chelating groups (abstract, col.1, line 57 through col.2, line 23, col.4, lines 1-31, Examples 2 and 3, table 1, claim 5). The process of making resin is described in col.2, lines 44-63, and includes the stating and resulting products as instantly claimed. Some of the resins having chelating functional groups as claimed are commercially available, as discussed in Surowies (col.4, lines 10-30). With regard to claim 18, see col.1, line 3.

Claims 17 and 18 are product-by-process claims. Because of the nature of product-by process claims, the Examiner cannot ordinarily focus on the precise difference between the claimed product and the disclosed product. It is then Applicants' burden to prove that an unobvious difference exists. See In re Marosi, 218 USPQ 289, 292-293 (CAFC 1983).

See also footnote 11 O.G. Notice 1162 59-61, wherein a 35 USC 102/103 rejection is authorized in the case of product-by-process claims because the exact identity of the claimed product or the prior art product cannot be determined by the Examiner.

Furthermore there is no evidence, or no reason to believe that the instantly claimed process produces a different product, that of a Surowiec, consult In re Thorpe, 227 USPQ 964 (CAFC 1985), wherein the Examiner rejected product-by-process claims over a product, which although prepared in a different manner, appeared to be the same (prima facie) as the claimed product.

In the instant case no Graham vs. John Deere analysis was made but rather the test set out in MPEP 706.03(e) and In re Marosi was applied while explaining why the claimed product does not patentably distinguish over the prior art under 35 USC 102/103. Consult also In re Brown, 173 USPQ 685 (CCPA 1972), the Court of Customs and Patent Appeals (CCPA) explicitly approved the 102/103 rejection of a product-by-process claim over a reference which showed a product which appeared to be identical or only slightly different from the claimed product. In other words, the patentability of the product is defined by the product per se, not by the process by which it was prepared.

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With regard to claims 19, 20, 23, 24 Surowiec teaches the method of using chelating group containing polymers to remove cations of calcium, magnesium, barium and strontium from brines and to remove metals, such as nickel, copper, zinc from waste streams (abstract, claims 10-16).

4. Claims 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surowiec.

Surowiec discloses the method of using chelating group containing polymers to remove cations of calcium, magnesium, barium and strontium from brines and to remove metals, such as nickel, copper, zinc from waste streams. However, she is silent about specific removal of rhodium or platinum group metals. However, Surowiec provides citation of two patents, i.e. 4,952,608 and 4,002,564, and recognizes that the chelating resins of these patents are essentially the same by their chemical make-up as in her patent. These resins re used to remove platinum, gold and silver from solution. Thus it would have been obvious to those skilled in the art to utilize the resins of Surowiec for the same purpose as she recites for substantially the same resins of the above two patents with the reasonable expectation of success.

#### ***Response to Arguments***

5. Applicant's arguments with respect to claims 17-24 have been considered but are moot in view of the new ground(s) of rejection.

6. However, Examiner would like to address Applicants reference to

In re Marzo(r-sic)cchi in the response filed September 1, 2004. *In re Marzocchi* has nothing in common with 35 USC 103(a) rejection, as applied by Applicants. It only refers to the issues of enablement, please consult MPEP 2164.04 [R-1].

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1115. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tatyana Zalukaeva  
Primary Examiner  
Art Unit 1713

A handwritten signature in black ink, appearing to read 'Tatyana Zalukaeva', with a long, sweeping horizontal stroke extending to the right.

November 29, 2004